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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/068,117 | 02/05/2002 | James D. Greene | WSIL 0160 PUS | 7381 |

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| EXAMINER |
|---|
| MOORE, MARGARET G |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1712 | 5 |

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 10/068,117 | Applicant(s) GREENE, JAMES D. | |
|---|---|---|---|
| | Examiner Margaret G. Moore | Art Unit 1712 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1 to 25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 to 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1 to 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaya et al.

Yamaya et al. teach polysiloxanes having functional epoxy groups. Particular attention is drawn to the examples, starting on column 21 through column 36, where various epoxy siloxanes are formed. For instance, Example 1 prepares a siloxane having Q and T units, thus meeting the M and D unit requirements in claim 1. This also meets the preferred E group of claim 2. Example 11 forms a siloxane having no alkoxy groups, meeting claim 3, as well as having an epoxy equivalent weight within the range of claim 4. Example 22 shows a siloxane having an epoxy equivalent weight within the range of claim 5, and a viscosity within the range of claim 6. All of these resins are prepared from trialkoxysilanes, forming T units meeting claim 8. Yamaya et al. do not indicate the molecular weight of these siloxanes but viscosity is related to molecular weight. In view of the fact that so many of the resins taught by Yamaya et al. fall within the claimed viscosity range, the skilled artisan would readily recognize that they will inherently fall within this broad molecular weight range as well.

With regards to claim 10, note that the bottom of column 12 teaches that the siloxanes can be made by reacting a silane (2) with a siloxane and/or silicone. See the bottom of column 13 through column 15 which details this reaction and reactants. Note

that various siloxanes shown fall within the claimed molecular weight range of claim 19. In this manner patentees anticipate the instant claims.

4. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaya et al.

With regards to claim 22, the Examiner notes that adjusting the molecular weight of the siloxanes in Yamaya et al. is well within the skill of the ordinary artisan since the teachings therein detail means for adjusting the degree of polymerization and condensation as well as adjusting the viscosity of the resulting siloxane. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation).

5. Claims 1 to 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Witucki et al.

Witucki et al. teach epoxy functional silicone resins. See for instance Example 1(a). The bottom of column 4 teaches that most of the alkoxy groups are hydrolyzed, thus producing a composition meeting the limitation of claim 3.

6. Claims 10 to 18 and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Witucki et al.

Witucki et al. do not teach that the silicone resins are prepared by reacting a silane with a silicone resin. However, this is a product by process type claim and the product, a silicone resin meeting having the formulas shown in claim 1, claimed appears to be the same product prepared by Witucki et al. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best,195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing

that they are not." In re Spada,15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best,195 USPQ 430, 433 (CCPA 1977).

With regards to claim 25, see Example 17, which contains a flow additive, a silicone resin (albeit not one prepared by the method claimed) and a curing catalyst, which qualifies as a hardener.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Witucki et al.

The bottom of column 5 teaches that acrylics may be used with the silicone resin therein when forming powder coating compositions. Thus one having ordinary skill in the art would have been motivated, for instance, to add an acrylic resin to the powder coating composition of Example 17, in view of the teaching by Witucki et al. that such resins can be used. This renders obvious the instant claim.

8. Claim 20 is neither taught nor suggested by the prior art. None of the references teach or suggest a resin having 70 mole % T units and 30 mole % D units, also having the E group as claimed, and a viscosity and epoxy equivalent weight value as claimed.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1 to 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 13 of U.S. Patent No. 6,344,520. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition claimed in '520 contains specific silicones that are embraced by the claimed silicones. Since the epoxy silicones in '520 are required by the claims therein, they render obvious the broader silicones claimed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
February 28, 2003